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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/955,572	10/22/1997	BYOUNG S. KWON	IND4-DI1B	7472
23643	7590	08/24/2007	EXAMINER	
BARNES & THORNBURG LLP 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204			LANDSMAN, ROBERT S	
ART UNIT		PAPER NUMBER		
1647				
MAIL DATE		DELIVERY MODE		
08/24/2007		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	08/955,572	KWON, BYOUNG S.	
	Examiner Robert Landsman, Ph.D.	Art Unit 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 August 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 5,6,24 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 5,6,24,26,28,29 and 31 is/are rejected.
- 7) Claim(s) 27 and 30 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***1. Formal Matters***

A. Claims 5, 6, 24 and 26-31 are pending and are the subject of this Office Action.

### ***2. Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

A. Claims 5, 6, 24 and 26, 28, 29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Goodwin et al. (US 7,211,259). The claims recite a protein of SEQ ID NO:2, an extracellular domain thereof and compositions comprising the protein. Goodwin teach a protein 100% identical to SEQ ID NO:2 (see Sequence Comparison A below), which comprises the extracellular fragment. Goodwin also teach compositions (claims 1-18). The rejection of claims 27 and 30 are not being maintained since Goodwin et al. do not teach a nucleic acid sequence 100% identical to those of SEQ ID NO:1, 2, 7 or 8 of the instant invention (see Sequence Comparison B below).

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**SEQUENCE COMPARISON A**

; Sequence 8, Application US/08060843A  
; GENERAL INFORMATION:  
; APPLICANT: Goodwin, Raymond G.  
; APPLICANT: Smith, Craig A.  
; TITLE OF INVENTION: Cytokine Designated 4-1BB Ligand And  
; TITLE OF INVENTION: Human Receptor That Binds Thereto  
; NUMBER OF SEQUENCES: 15  
; CORRESPONDENCE ADDRESS:  
; ADDRESSEE: Kathryn A. Seese, Immunex Corporation  
; STREET: 51 University Street  
; CITY: Seattle  
; STATE: Washington  
; COUNTRY: US  
; ZIP: 98101  
; COMPUTER READABLE FORM:  
; MEDIUM TYPE: Floppy disk  
; COMPUTER: IBM PC compatible  
; OPERATING SYSTEM: PC-DOS/MS-DOS  
; SOFTWARE: PatentIn Release #1.0, Version #1.25  
; CURRENT APPLICATION DATA:  
; APPLICATION NUMBER: US/08/060,843A  
; FILING DATE: 19930507  
; CLASSIFICATION: 530  
; ATTORNEY/AGENT INFORMATION:  
; NAME: Seese,, Kathryn A.  
; REGISTRATION NUMBER: 32,172  
; REFERENCE/DOCKET NUMBER: 2801-A  
; TELECOMMUNICATION INFORMATION:  
; TELEPHONE: (206) 587-0430  
; TELEFAX: (206) 233-0644  
; INFORMATION FOR SEQ ID NO: 8:  
; SEQUENCE CHARACTERISTICS:  
; LENGTH: 255 amino acids  
; TYPE: amino acid  
; TOPOLOGY: linear  
; MOLECULE TYPE: protein

US-08-060-843A-8

Query Match 100.0%; Score 1415; DB 1; Length 255;  
Best Local Similarity 100.0%; Pred. No. 0;  
Matches 255; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

Qy 1 MGNSCYNIVATLLLVLNFERTRSLQDPCSNCPAGTFCDNNRNQICSPCPPNSFSSAGGQR 60  
Db 1 MGNSCYNIVATLLLVLNFERTRSLQDPCSNCPAGTFCDNNRNQICSPCPPNSFSSAGGQR 60

Qy 61 TCDICRQCKGVFRTRKECSSTSNAECDCPTGFHCLGAGCSMCEQDCKQGQELTKKGCKDC 120  
Db 61 TCDICRQCKGVFRTRKECSSTSNAECDCPTGFHCLGAGCSMCEQDCKQGQELTKKGCKDC 120

Qy 121 CFGTFNDQKRGICRPWTNCSDGKSVLVNGTKERDVVCGPSPADLSPGASSVTAPPAPARE 180  
Db 121 CFGTFNDQKRGICRPWTNCSDGKSVLVNGTKERDVVCGPSPADLSPGASSVTAPPAPARE 180

Qy 181 PGHSPQIISFFFLALTSTALLFLLFLTLRFSVVKRGRKKLLYIFKQPFMRPVQTTQEEEDG 240  
Db 181 PGHSPQIISFFFLALTSTALLFLLFLTLRFSVVKRGRKKLLYIFKQPFMRPVQTTQEEEDG 240

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Qy            241 CSCRFPEEEEGGCEL 255  
               |||||||  
 Db            241 CSCRFPEEEEGGCEL 255

### SEQUENCE COMPARISON B

; Sequence 7, Application US/08060843A  
 Query Match                            99.8%; Score 836.4; DB 1; Length 1415;  
 Best Local Similarity                99.9%; Pred. No. 2e-84;  
 Matches 837; Conservative 0; Mismatches 1; Indels 0; Gaps 0;

Qy            1 AATCAGTTGCTAGTATCATACCTGTGCCAGATTTCATCATGGAAACAGCTGTTACAA 60  
               |||||||  
 Db            80 AATCAGTTGCTAGTATCATACCTGTGCCAGATTTCATCATGGAAACAGCTGTTACAA 139

Qy            61 CATAGTAGCCACTCTGTTGCTGGTCCTCAACTTGGAGAGGACAAGATCATTGCAGGATCC 120  
               |||||||  
 Db            140 CATAGTAGCCACTCTGTTGCTGGTCCTCAACTTGGAGAGGACAAGATCATTGCAGGATCC 199

Qy            121 TTGTAGTAACGCCAGCTGGTACATTCTGTGATAATAACAGGAATCAGATTGCAGTCC 180  
               |||||||  
 Db            200 TTGTAGTAACGCCAGCTGGTACATTCTGTGATAATAACAGGAATCAGATTGCAGTCC 259

Qy            181 CTGTCCTCCAAATAGTTCTCCAGCGCAGGTGGACAAAGGACCTGTGACATATGCAGGCA 240  
               |||||||  
 Db            260 CTGTCCTCCAAATAGTTCTCCAGCGCAGGTGGACAAAGGACCTGTGACATATGCAGGCA 319

Qy            241 GTGTAAAGGTGTTTCAGGACCAGGAAGGGAGTGTTCCTCCACCAAGCAATGCAGAGTGTGA 300  
               |||||||  
 Db            320 GTGTAAAGGTGTTTCAGGACCAGGAAGGGAGTGTTCCTCCACCAAGCAATGCAGAGTGTGA 379

Qy            301 CTGCACTCCAGGGTTTCACTGCCTGGGGCAGGATGCAGCATGTGTGAACAGGATTGTAA 360  
               |||||||  
 Db            380 CTGCACTCCAGGGTTTCACTGCCTGGGGCAGGATGCAGCATGTGTGAACAGGATTGTAA 439

Qy            361 ACAAGGTCAAGAACTGACAAAAAAAGGTTGTAAGACTGTTGCTTGGACATTTAACGA 420  
               |||||||  
 Db            440 ACAAGGTCAAGAACTGACAAAAAAAGGTTGTAAGACTGTTGCTTGGACATTTAACGA 499

Qy            421 TCAGAACGTGGCATCTGCGACCCCTGGACAAACTGTTCTTGGATGGAAAGTCTGTGCT 480  
               |||||||  
 Db            500 TCAGAACGTGGCATCTGCGACCCCTGGACAAACTGTTCTTGGATGGAAAGTCTGTGCT 559

Qy            481 TGTGAATGGGACGAAGGAGAGGGACGTGGCTGTGGACCATCTCCAGCTGACCTCTCC 540  
               |||||||  
 Db            560 TGTGAATGGGACGAAGGAGAGGGACGTGGCTGTGGACCATCTCCAGCCGACCTCTCC 619

Qy            541 GGGAGCATCCTCTGTGACCCCGCCTGCCCTGCGAGAGAGCCAGGACACTCTCCGAGAT 600  
               |||||||  
 Db            620 GGGAGCATCCTCTGTGACCCCGCCTGCCCTGCGAGAGAGCCAGGACACTCTCCGAGAT 679

Qy            601 CATCTCCTCTTCTTGCCTGCGCTGACGTCGACTGCGTTGCTCTCCCTGCTGTTCTCCTCAC 660  
               |||||||  
 Db            680 CATCTCCTCTTCTTGCCTGCGCTGACGTCGACTGCGTTGCTCTCCCTGCTGTTCTCCTCAC 739

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Qy 661 GCTCCGTTCTCTGTTAACGGGGCAGAAAGAAACTCCTGTATATATTCAAACAAACC 720  
Db 740 GCTCCGTTCTCTGTTAACGGGGCAGAAAGAAACTCCTGTATATATTCAAACAAACC 799

Qy 721 ATTTATGAGACCAGTACAAACTACTCAAGAGGAAGATGGCTGTAGCTGCCGATTCAGA 780  
Db 800 ATTTATGAGACCAGTACAAACTACTCAAGAGGAAGATGGCTGTAGCTGCCGATTCAGA 859

Qy 781 AGAAGAAGAAGGAGGATGTGAACGTGAAATGGAAGTCAATAGGGCTGTTGGGACTTT 838  
Db 860 AGAAGAAGAAGGAGGATGTGAACGTGAAATGGAAGTCAATAGGGCTGTTGGGACTTT 917

### 3. Conclusion

*ML  
8.15.07*

A. Claims 27 and 30 would be allowable if rewritten in independent format as product-by-process claims. *Currently, These claims are objected to since they depend from rejected claims.*

### Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (571) 272-0888. The examiner can normally be reached on M-F 10 AM – 7 PM (eastern).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath Rao at 571-272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert Landsman, Ph.D.  
Primary Examiner  
Art Unit 1647